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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,129	08/02/2001	Anne Flisher		1828

324 7590 09/17/2003

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PATENT DEPARTMENT  
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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/890,129

Applicant(s)

FLISHER ET AL.

Examiner

Susan W Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Response to Amendment***

The rejections of claims under 35 USC 112 are withdrawn in response to amended claims 3, 17 and 18.

***Response to Arguments***

The Declaration under Rule 1.131 of Anne Flisher, Gareth I. Naylor and Lee Raistrick submitted 06-13-2003 has been considered. However, a Declaration under Rule 1.131 is not deemed appropriate because applicant is claiming an invention that appears to be the same patentable invention as that claimed in US 6,262,141 B1. See MPEP 715 and 2308.02 and the specific citations herein below.

**715 [R-1] Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131**

**SITUATIONS WHERE 37 CFR 1.131 AFFIDAVITS OR DECLARATIONS ARE INAPPROPRIATE**

An affidavit or declaration under 37 CFR 1.131 is not appropriate in the following situations:

(B) Where the reference U.S. patent or U.S. patent application publication claims the same patentable invention. See MPEP § 715.05 for a discussion of "same patentable invention" and MPEP § 2306. Where the reference patent and the application or patent under reexamination are commonly owned, and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, a terminal disclaimer and an affidavit or declaration under 37 CFR 1.130 may be used to overcome a rejection under 35 U.S.C. 103. See MPEP § 718.

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**2308.02 Showing Under 37 CFR 1.608(b)**

The showing under 37 CFR 1.608(b) must be such as to show that the applicant is *prima facie* entitled to a judgment relative to the patentee. 35 U.S.C. 135(a) gives the Board jurisdiction in an interference proceeding over questions of both priority and patentability. Therefore, the 37 CFR 1.608(b) showing need not attempt to show prior invention by the applicant. Instead, it may demonstrate that the applicant would be entitled to a judgment against the patentee on a ground of unpatentability which does not apply to applicant's claims (as, for example, that the claims of the patent which will correspond to the court or courts are unpatentable over prior art or prior public use, or that the patent does not comply with 35 U.S.C. 112). Note, however, the last paragraph of this section.

An applicant in preparing affidavits or declarations under 37 CFR 1.608(b) to provoke an interference with a patentee whose effective U.S. filing date antedates the applicant's by more than 3 months, should have in mind the provisions of 37 CFR 1.617, and especially the following

- (A) After these affidavits or declarations are forwarded by the primary examiner

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for the declaration of an interference, they will be examined by an administrative patent judge.

(B) If the affidavits or declarations fail to establish that applicant would *prima facie* be entitled to a judgment relative to the patentee, an order will be issued concurrently with the notice of interference, requiring applicant to show cause why summary judgment should not be entered against the applicant.

(C) Additional evidence in response to such order will not be considered unless justified by a showing under the provisions of 37 CFR 1.617(b). If the applicant responds, the applicant must serve the patentee and any other opponents with a copy of the original showing under 37 CFR 1.608(b) and of the response, and they will be entitled to present their views with respect thereto (37 CFR 1.617(d)).

(D) All affidavits or declarations submitted must describe acts which the affiants performed or observed, or circumstances observed, such as structure used and results of use or test, except on a proper showing as provided in 37 CFR 1.608(b). Statements of conclusion, for example, that the invention of the counts was reduced to practice, are generally considered to be not acceptable. It should also be kept in mind that documentary exhibits which are not self-authenticated must be authenticated and discussed with particularity by an affiant having direct knowledge of the matters involved. However, it is not necessary that the exact date of conception or reduction to practice be revealed in the affidavits, declarations, or exhibits if the affidavits or declarations aver observation of the necessary acts and facts, including documentation when available, before the patentee's effective filing date. On the other hand, where reliance is placed upon diligence, the affidavits or declarations and documentation should be precise as to dates from a date just prior to patentee's effective filing date. The showing should relate to the essential factors in the determination of the question of priority of invention as set out in 35 U.S.C. 102(g).

(E) The explanation required by 37 CFR 1.608(b) should be in the nature of a brief or of explanatory remarks accompanying an amendment. The explanation should set forth the manner in which the requirements of the counts are satisfied and how the requirements for conception, reduction to practice, or diligence are met, or otherwise explain the basis on which the applicant is *prima facie* entitled to a judgment.

(F) Published decisions of the Court of Appeals for the Federal Circuit, Court of Customs and Patent Appeals and the Board of Patent Interferences concerning the quantum of proof required by an applicant to make out a *prima facie* showing entitling the applicant to an award of priority with respect to the filing date of a patent so as to allow the interference to proceed, 37 CFR 1.617(a), second sentence, include *Schendel v. Curtis*, 83 F.3d 1399, 38 USPQ2d 1743 (Fed. Cir. 1996); *Hahn v. Wong*, 892 F.2d 1028, 13 USPQ2d 1313 (Fed. Cir. 1989); *Wetmore v. Quick*, 536 F.2d 937, 190 USPQ 223 (CCPA 1976); *Golota v. Strom*, 489 F.2d 1287, 180 USPQ 396 (CCPA 1974); *Schwab v. Pittman*, 451 F.2d 637, 172 USPQ 69 (CCPA 1971); *Kistler v. Weber*, 412 F.2d 280, 162 USPQ 214 (CCPA 1969); *Azar v. Burns*, 188 USPQ 601 (Bd. Pat. Int. 1975); *Horvitz v. Pritchard*, 182 USPQ 505 (Bd. Pat. Int. 1974); and *Murphy v. Eiseman*, 166 USPQ 149 (Bd. Pat. Int. 1970).

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With respect to claims 19 and 20, applicant argues that the cited references do not specifically disclose the instant claim recitation of an amount of residual monomer below 100 ppm. This argument is not persuasive for the following reasons. The processes disclosed in the prior art would be expected to produce polymers in which the amount of residual monomer is below 100 ppm because the process steps, exposure of the same monomeric compositions to conventional initiators and UV light, would be expected to provide a similar product to the process steps set forth in the instant claims 1 and 4. Kanlun et al teach a high conversion of monomer and discloses yields over 99% (column 4, lines 38-44). Baumstark et al teach a process for reducing the residual monomer content (see the Abstract and Table 1. The burden of proof is shifted to applicant to show that the prior art products do not have the instantly claimed low residual monomer content.

EP 0 290 814 teaches that the material obtained by the disclosed process has an "extremely reduced amount of unreacted monomers" (page 4, lines 27-34). ). However, the rejection over EP '814 is withdrawn in response to applicant's request for reconsideration in view of the results for "unpolymerized monomer concentration" shown in Table 1 since only one out of 17 Examples provided less than 100 ppm (Ex. 17). The rejection over Perrault (5,800,685) is withdrawn.

### *Claim Rejections - 35 USC § 102*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 and 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Cywar et al (6,262,141). Cywar et al teach polymerizing vinyl monomers, including acrylamide, in aqueous solution activated by in the presence of redox initiators or a thermal initiator and in the presence of an ultraviolet photoinitiator. The product is then irradiated with an intensity such as 15 mW/cm<sup>2</sup> during the period of drying. See column 4, lines 25-39, lines 46-67, column 5, lines 23-34, the "Gelled Polymer Synthesis"

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and Example 1. With respect to claim 5, the polymers disclosed by Cywar et al would be expected to have the instantly claimed intrinsic viscosity because the polymers produced are provided by the same monomers and method steps as are instantly claimed.

Claims 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by each of Kanlun et al (5,185,385) and Baumstark et al (5,756,574). The crosslinked polymers disclosed, although produced by different process steps, would not be expected to be materially different in structure or properties from the instantly claimed products. The processes disclosed in the prior art would be expected to produce polymers in which the amount of residual monomer is below 100 ppm because the process steps, exposure of the same monomeric compositions to conventional initiators and UV light, would be expected to provide a similar product to the process steps set forth in the instant claims 1 and 4. Kanlun et al teach a high conversion of monomer and discloses yields over 99% (column 4, lines 38-44). Baumstark et al teach a process for reducing the residual monomer content (see the Abstract and Table 1. EP 0 290 814 teaches that the material obtained by the disclosed process has an "extremely reduced amount of unreacted monomers" (page 4, lines 27-34).

***Claim Rejections - 35 USC § 103***

Claims 1-11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 290 814 in view of Cywar et al '141. EP '814 discloses the instantly claimed method except for adding an ultraviolet initiator to the monomer mixture. Cywar et al, in analogous art, teach that vinyl monomers can be polymerized in aqueous solution by activation of redox or thermal initiators in the presence of an ultraviolet initiator. It would have been obvious to one skilled in the art at the time of the invention to add an ultraviolet initiator to the monomer mix in the method disclosed by EP '814 in order to take advantage of the initiating properties of the ultraviolet initiator during the step of irradiation with ultraviolet light.

*Conclusion*


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman  
Primary Examiner  
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